



1631  
PTO/SB/21 (01-08)

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 20 Attorney Docket Number 02307O-175400US

Application Number 09/765,291

Filing Date January 22, 2001

First Named Inventor Gray, Joe W.

Art Unit 1631

Examiner Name Marjorie A. Moran

### ENCLOSURES (Check all that apply)

Fee Transmittal Form - PTO/SB/17I  
in duplicate

Fee Attached

Amendment/Reply

After Final

Affidavits/declaration(s)

Extension of Time Request

Express Abandonment Request

Information Disclosure Statement

Certified Copy of Priority  
Document(s)

Reply to Missing Parts/ Incomplete  
Application

Reply to Missing Parts  
under 37 CFR 1.52 or 1.53

Drawing(s)

Licensing-related Papers

Petition

Petition to Convert to a  
Provisional Application

Power of Attorney, Revocation  
Change of Correspondence Address

Terminal Disclaimer

Request for Refund

CD, Number of CD(s) \_\_\_\_\_

Landscape Table on CD

After Allowance Communication to TC

Appeal Communication to Board  
of Appeals and Interferences

Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)

Proprietary Information

Status Letter

Other Enclosure(s) (please identify  
below):

1)-Request for Correction of Inventorship

2)-Statement of Inventor re Correction;

3)-Consent of Assignee to Correction;

4)-Declaration Using ADS (4 counterparts)

5)-ADS

6)-Return Postcard

Remarks The Commissioner is authorized to charge any additional fees to Deposit  
Account 20-1430.

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name Townsend and Townsend and Crew LLP

Signature

Printed name Jean M. Lockyer, Ph.D.

Date January 25, 2008

Reg. No. 44,879

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature

Typed or printed name

Malinda C. Dagit

Date


**PROCESSING FEE**
**Under 37 CFR 1.17(i)**
**TRANSMITTAL**

(Fees are subject to annual revision)

 Send completed form to: Commissioner for Patents  
 P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	09/765,291
Filing Date	January 22, 2001
First Named Inventor	Gray, Joe W.
Art Unit	1631
Examiner Name	Marjorie A. Moran
Attorney Docket Number	023070-175400US

Enclosed is a paper filed under 37 CFR §1.48 that requires a processing fee (37 CFR 1.17(i)).  
**Payment of \$ 130** is enclosed.

This form should be included with the above-mentioned paper and faxed or mailed to the Office using the appropriate Mail Stop, if applicable. For transmittal of petition fees under 37 CFR 1.17(f), (g) or (h), see form PTO/SB/17p.

**Payment of Fees** (small entity amounts are NOT available for the processing fees)

The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 20-1430:

processing fee under 37 CFR 1.17(i)  any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

Check in the amount of \$ \_\_\_\_\_ is enclosed.

Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Processing Fees under 37 CFR 1.17(i): Fee \$130 Fee Code 1808 for all,  
 Except for § 1.221 papers (Fee Code 1803)**

For papers filed under:

§ 1.28(c)(3) - for processing a non-itemized fee deficiency based on an error in small entity status.

§ 1.41 - for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by § 1.63, except in provisional applications.

✓ § 1.48 - for correcting inventorship, except in provisional applications.

§ 1.52(d) - for processing a nonprovisional application filed with a specification in a language other than English.

§ 1.53(b)(3) - to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§ 1.55 - for entry of late priority papers.

§ 1.71(g)(2) - to enter an amendment to the specification for purposes of 35 U.S.C. 103(c)(2) if not filed within the cited time periods

§ 1.99(e) - for processing a belated submission under § 1.99.

§ 1.103(b) - for requesting limited suspension of action, continued prosecution application (§ 1.53(d)).

§ 1.103(c) - for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d) - for requesting deferred examination of an application.

§ 1.217 - for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221 - for requesting voluntary publication or republication of an application. **Fee Code 1803**

§ 1.291(c)(5) - for processing a second or subsequent protest by the same real party in interest.

§ 1.497(d) - for filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage.

§ 3.81 - for a patent to issue to assignee, assignment submitted after payment of the issue fee.

Signature

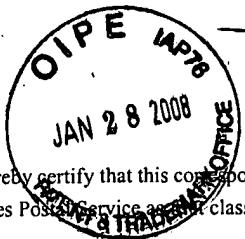
Jean M. Lockyer, Ph.D.

Typed or printed name

Date

44,879

Registration No., if applicable



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

**PATENT**  
Attorney Docket No.: 02307O-175400US

Commissioner for Patents  
Alexandria, VA 22313-1450

on 25 Jan. 2008

TOWNSEND and TOWNSEND and CREW LLP

By: Malvina Dajat

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Gray, et al.

Application No.: 09/765,291

Filed: January 22, 2001

For: CHROMOSOME SPECIFIC  
STAINING TO DETECT GENETIC  
REARRANGEMENTS

Customer No.: 20350

Confirmation No. 9405

Examiner: Marjorie A. Moran

Technology Center/Art Unit: 1631

**REQUEST FOR**  
**CORRECTION OF INVENTORSHIP**  
**UNDER 37 CFR §1.48(c)**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

It is respectfully requested that the inventorship in the above-identified application be amended to include one additional inventor: Carol Westbrook. The following required documents are enclosed:

(1)-STATEMENT OF INVENTOR RE CORRECTION OF INVENTORSHIP executed  
by added inventor;

01/28/2008 CCHAU1 00000085 201430 09765291

01 FC:1464 130.00 DA

(2)-DECLARATION FOR UTILITY APPLICATION USING AN APPLICATION  
DATA SHEET executed by all four inventors (in four counterparts);  
(3)-APPLICATION DATA SHEET  
(4)-CONSENT OF ASSIGNEE TO CORRECTION OF INVENTORSHIP;  
(5)-FEE TRANSMITTAL PTO/SB/17i with authorization to deduct the processing fee  
under 37 CFR §1.17(i) from our deposit account (in duplicate).

Respectfully submitted,

Jean M. Lockyer  
Reg. No. 44,879

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
JML:jml  
61265814 v1



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

PATENT  
Attorney Docket No.: 02307O-175400US  
UC Case no. 95-327-2

Commissioner for Patents  
Alexandria, VA 22313-1450

On 25 Jan. 2008

TOWNSEND and TOWNSEND and CREW LLP

By: Malinda A. Dagit

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Joe W. Gray *et al.*

Application No.: 09/765,291

Filed: January 22, 2001

For: CHROMOSOME SPECIFIC  
STAINING TO DETECT GENETIC  
REARRANGEMENTS

Examiner: Marjorie A. Moran

Art Unit: 1631

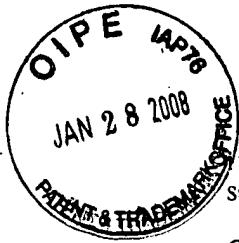
**STATEMENT OF INVENTOR RE  
CORRECTION OF INVENTORSHIP  
UNDER 37 C.F.R. §1.48(c)**

Commissioner for Patents  
Alexandria, VA 22313-1450

Sir:

I state that the addition of myself as an inventor is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on my part.

Dated: 11-18-2007 By Carol Westbrook  
Carol Westbrook



hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents  
Alexandria, VA 22313-1450

On 25 Jan. 2008

TOWNSEND and TOWNSEND and CREW LLP

By: Malinda A. Agajit

**PATENT**  
Attorney Docket No.: 023070-175400US  
UC Case no. 95-327-2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Joe W. Gray *et al.*

Application No.: 09/765,291

Filed: January 22, 2001

For: CHROMOSOME SPECIFIC  
STAINING TO DETECT GENETIC  
REARRANGEMENTS

Examiner: Marjorie A. Moran

Art Unit: 1631

**CONSENT OF ASSIGNEE TO  
CORRECTION OF INVENTORSHIP  
UNDER 37 C.F.R. §1.48 (c)**

Commissioner for Patents  
Alexandria, VA 22313-1450

Sir:

The Regents of the University of California, owner by assignment from inventors Joe W. Gray, Daniel Pinkel and Douglas Tkachuk, recorded in the USPTO at reel/frames 5515/0460 and 5650/0655, hereby consents to correction of the inventorship in the above-identified application to include inventor Carol Westbrook.

The Regents of the University of California

Dated: November 21, 2007

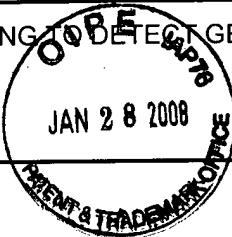
By John Shih

Name: John Shih

Title: Interim Manager Patent Prosecution

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)**

Title of Invention	CHROMOSOME SPECIFIC STAINING TO DETECT GENETIC REARRANGEMENTS
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As the below named inventor(s), I/we declare that:

This declaration is directed to:

The attached application, or  
 Application No. 09/765,291, filed on January 22, 2001,  
 as amended on \_\_\_\_\_ (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

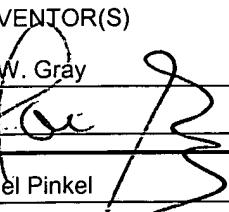
I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

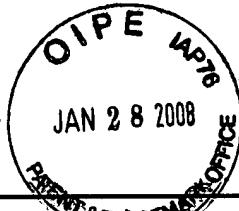
All statements made herein of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR(S)	
Inventor one: Joe W. Gray	Date: 12/5/07
Signature: 	Citizen of: United States
Inventor two: Daniel Pinkel	Date: _____
Signature: 	Citizen of: United States
<input checked="" type="checkbox"/> Additional inventors or a legal representative are being named on _____ additional form(s) attached hereto.	

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN  
APPLICATION DATA SHEET (37 CFR 1.76) –  
ADDITIONAL INVENTOR(S)  
Supplemental Sheet 1 of 0**

**FULL NAME OF INVENTOR(S)**

Inventor three: Douglas Tkachuk	Date: _____
Signature: _____	Citizen of: Canada
Inventor four: Carol Westbrook	Date: _____
Signature: _____	Citizen of: United States
Inventor five: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor six: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor seven: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor eight: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor nine: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor ten: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor eleven: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor twelve: _____	Date: _____
Signature: _____	Citizen of: _____



## DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)

Title of Invention	CHROMOSOME SPECIFIC STAINING TO DETECT GENETIC REARRANGEMENTS
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The attached application, or  
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I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

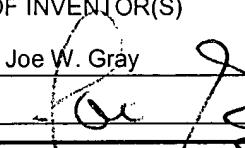
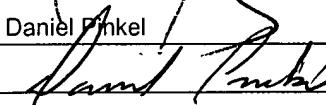
I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

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All statements made herein of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR(S)	
Inventor one: Joe W. Gray	Date: 12/5/07
Signature: 	Citizen of: United States
Inventor two: Daniel Pinkel	Date: 12-20-07
Signature: 	Citizen of: United States
<input checked="" type="checkbox"/> Additional inventors or a legal representative are being named on _____ additional form(s) attached hereto.	

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN  
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ADDITIONAL INVENTOR(S)  
Supplemental Sheet 1 of 0**

**FULL NAME OF INVENTOR(S)**

Inventor three: Douglas Tkachuk	Date: _____
Signature: _____	Citizen of: Canada
Inventor four: Carol Westbrook	Date: _____
Signature: _____	Citizen of: United States
Inventor five: _____	Date: _____
Signature: _____	Citizen of: _____
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Inventor nine: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor ten: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor eleven: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor twelve: _____	Date: _____
Signature: _____	Citizen of: _____



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I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

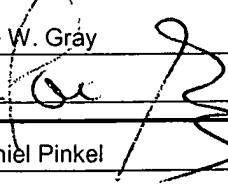
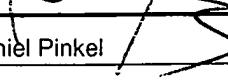
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FULL NAME OF INVENTOR(S)	
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Signature: 	Citizen of: <u>United States</u>
Inventor two: <u>Daniel Pinkel</u>	Date: _____
Signature: 	Citizen of: <u>United States</u>
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APPLICATION DATA SHEET (37 CFR 1.76) –  
ADDITIONAL INVENTOR(S)  
Supplemental Sheet 1 of 0**

**FULL NAME OF INVENTOR(S)**

Inventor three: Douglas Tkachuk

Date: 10 Jan 2005

Signature: 

Citizen of: Canada and United States

Inventor four: Carol Westbrook

Date:

Signature:

Citizen of: United States

Inventor five:

Date:

Signature:

Citizen of:

Inventor six:

Date:

Signature:

Citizen of:

Inventor seven:

Date:

Signature:

Citizen of:

Inventor eight:

Date:

Signature:

Citizen of:

Inventor nine:

Date:

Signature:

Citizen of:

Inventor ten:

Date:

Signature:

Citizen of:

Inventor eleven:

Date:

Signature:

Citizen of:

Inventor twelve:

Date:

Signature:

Citizen of:



## DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)

Title of Invention	CHROMOSOME SPECIFIC STAINING TO DETECT GENETIC REARRANGEMENTS
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I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

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FULL NAME OF INVENTOR(S)	
Inventor one: Joe W. Gray	Date: _____
Signature: _____	Citizen of: United States
Inventor two: Daniel Pinkel	Date: _____
Signature: _____	Citizen of: United States
<input checked="" type="checkbox"/> Additional inventors or a legal representative are being named on _____ additional form(s) attached hereto.	

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN  
APPLICATION DATA SHEET (37 CFR 1.76) –  
ADDITIONAL INVENTOR(S)  
Supplemental Sheet 1 of 0**

**FULL NAME OF INVENTOR(S)**

Inventor three: Douglas Tkachuk Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: Canada

Inventor four: Carol Westbrook Date: 11-18-07

Signature: *Carol Westbrook* Citizen of: United States

Inventor five: \_\_\_\_\_ Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: \_\_\_\_\_

Inventor six: \_\_\_\_\_ Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: \_\_\_\_\_

Inventor seven: \_\_\_\_\_ Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: \_\_\_\_\_

Inventor eight: \_\_\_\_\_ Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: \_\_\_\_\_

Inventor nine: \_\_\_\_\_ Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: \_\_\_\_\_

Inventor ten: \_\_\_\_\_ Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: \_\_\_\_\_

Inventor eleven: \_\_\_\_\_ Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: \_\_\_\_\_

Inventor twelve: \_\_\_\_\_ Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: \_\_\_\_\_



## Application Data Sheet

### **Application Information**

Application number:: 09/765,291  
Filing Date:: 01/22/01  
Application Type:: Regular  
Subject Matter:: Utility  
Suggested classification::  
Suggested Group Art Unit::  
CD-ROM or CD-R??::  
Number of CD disks::  
Number of copies of CDs::  
Sequence Submission::  
Computer Readable Form (CRF)?::  
Number of copies of CRF::  
Title:: Chromosome Specific Staining to Detect Genetic Rearrangements  
Attorney Docket Number:: 023070-175400US  
Request for Early Publication:: No  
Request for Non-Publication:: No  
Suggested Drawing Figure::  
Total Drawing Sheets:: 12  
Small Entity?:: No  
Latin name::  
Variety denomination name::  
Petition included?:: No  
Petition Type::  
Licensed US Govt. Agency::  
Contract or Grant Numbers One::  
Secrecy Order in Parent Appl.?:: No

### **Applicant Information**

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Joe  
Middle Name:: W.  
Family Name:: Gray  
Name Suffix::  
City of Residence:: Livermore  
State or Province of Residence:: CA  
Country of Residence:: US  
Street of Mailing Address:: 1760 Lomitas  
City of Mailing Address:: Livermore  
State or Province of mailing address:: CA  
Country of mailing address:: US  
Postal or Zip Code of mailing address:: 94550

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Daniel  
Middle Name::  
Family Name:: Pinkel  
Name Suffix::  
City of Residence:: Lafayette  
State or Province of Residence:: CA  
Country of Residence:: US  
Street of Mailing Address:: 1098 Via Roble  
City of Mailing Address:: Lafayette  
State or Province of mailing address:: CA

Country of mailing address:: US

Postal or Zip Code of mailing address:: 94549

Applicant Authority Type:: Inventor

Primary Citizenship Country:: Canada and US

Status:: Full Capacity

Given Name:: Douglas

Middle Name::

Family Name:: Tkachuk

Name Suffix::

City of Residence:: Toronto

State or Province of Residence:: Ontario

Country of Residence:: Canada

Street of Mailing Address:: 333 Glencairn Avenue

City of Mailing Address:: Toronto

State or Province of mailing address:: Ontario

Country of mailing address:: Canada

Postal or Zip Code of mailing address:: M5N1T8

Applicant Authority Type:: Inventor

Primary Citizenship Country:: US

Status:: Full Capacity

Given Name:: Carol

Middle Name::

Family Name:: Westbrook

Name Suffix::

City of Residence:: Goshen

State or Province of Residence:: IN

Country of Residence:: US

Street of Mailing Address:: 19902 Bluff Drive

City of Mailing Address:: Goshen

State or Province of mailing address:: IN  
Country of mailing address:: US  
Postal or Zip Code of mailing address:: 46526

### **Correspondence Information**

Correspondence Customer Number:: 20350

### **Representative Information**

Representative Customer Number:: 20350

### **Domestic Priority Information**

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This application is	Division of	08/487,974	06/07/1995
08/487,974	Continuation of	08/342,028	11/16/1994
08/342,028	Continuation of	08/181,367	01/14/1994
08/181,367	Continuation of	08/054,353	04/28/1993
08/054,353	Continuation of	07/537,305	06/12/1990

### **Foreign Priority Information**

Country:: Application number:: Filing Date::

### **Assignee Information**

Assignee Name:: The Regents of the University of California  
Street of mailing address:: 1111 Franklin Street, 12th Floor  
City of mailing address:: Oakland  
State or Province of mailing address:: CA  
Country of mailing address:: US  
Postal or Zip Code of mailing address:: 94607  
and

Assignee Name:: The University of Chicago  
Street of mailing address:: 5801 South Ellis Avenue

City of mailing address:: Chicago

State or Province of mailing address:: IL

Country of mailing address:: US

Postal or Zip Code of mailing address:: 60637